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09/765,605	01/22/2001	Mario Polegato Moretti	202115US3	9737

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
3728	16

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 16

Application Number: 09/765,605  
Filing Date: January 22, 2001  
Appellant(s): Mario P. Moretti

Gregory J. Maier  
For Appellant

EXAMINER'S ANSWER

MAILED

APR 15 2003

GROUP 3700

This is in response to appellants brief on appeal filed February 26, 2003.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

***(2) Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

***(3) Status of Claims***

The statement of the status of the claims contained in the brief is correct.

***(4) Status of Amendments After Final***

No amendment after final has been filed.

***(5) Summary of Invention***

The summary of invention contained in the brief is correct.

***(6) Issues***

The appellant's statement of the issues in the brief is correct.

***(7) Grouping of Claims***

Appellant's brief includes a statement that claims 1-8 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c) (7) and (c) (8).

***(8) ClaimsAppealed***

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A substantially correct copy of appealed claims 1-8 appears on pages 9 and 10 of the Appendix to the appellant's brief. The minor errors are as follows: Claim 1, line 2 after "and", the word --is--has been incorrectly added; line 4, after "and", the word --which--has been inadvertently omitted.

*(9) Prior Art of Record*

4,100,685	Dassler	06-1978
5,983,524	Polegato	11-1999
4,771,555	Ohashi	09-1988
6,282,813	Squadroni	09-2001
4,682,425	Simmons	07-1987
2,347,207	Margolin	04-1944

*(10) Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

*Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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2. Claims 1 and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dassler 4,100,685 in view of Ohashi 4,771,555, Polegato 5,983,524 and Squadroni 6,282,813. Dassler '685 discloses all the limitations substantially as claimed including the following: a sole 5 with a tread (bottom ground-engaging portion of the sole) with through holes 8 extending through the thickness of the tread (see Figure 1); inserts 9 assembled in the through holes; the inserts 9 having a through holes through them (See col. 3, lines 45-48, must have holes so as not to detract from the desired ventilation) to allow vapor to pass there through. Dassler '685 does not teach the tread being made of leather and at least partially covered in an upward region by a membrane that is permeable to vapor and impermeable to water and sealed in the peripheral regions with respect to the tread, the details with respect to the membrane, the protective layer used to protect the membrane, the undercuts in the inserts; and the inserts assembled by injection molding. Ohashi '555 teaches that inserts used to ventilate a shoe can be made of plastic (see col. 3, lines 56-57, synthetic resin is a plastic material) with undercuts 15 (used to hold the inserts within the sole) to aid in holding the hole open to allow for air to flow through. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was

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made, to use inserts made of plastic, as taught by Ohashi '555, as the inserts of Dassler '685 to allow for air to flow through and ventilate the shoe while supporting the opening in the sole of the shoe. Squadroni '813 teaches that it is desirable to ventilate a shoe sole made of leather (see col. 2, lines 65-68) to allow for the foot of the user to breathe when located within the shoe. Therefore, it would have been obvious to make the shoe sole of Dassler '685 out of leather, or any other known sole material, and ventilate it as taught by the combination above, to allow for the foot of the user to breathe and prevent fluid build-up in the shoe of the user. Polegato '524 teaches that it is desirable to make the ventilated sole of a shoe impermeable to water yet permeable to vapor to allow for the user's foot to breathe. This is accomplished by covering an upward region of the shoe sole by a membrane 315 made of a material which is permeable to vapor and impermeable to water. To further seal or waterproof the shoe sole, Polegato '524 teaches that the membrane can be sealed to the tread in a peripheral region (see col. 5, lines 54-59). The tread and membrane are further sealed peripherally by a peripheral band 315a and sealed perimetrical by adhesive (see Figures 5-7). Polegato '524 further teaches that a protective layer 316 can be arranged at the upper outlets of through holes to protect the

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membrane with a vapor permeable or perforated protective layer located above the membrane 318. Polegato '524 also teaches that the sole can be injection molded (See column 6, lines 29-67). Therefore, it would have been obvious to place a vapor permeable membrane with a protective layer, such as that taught by Polegato '524, on the upward side of the sole of the references as modified above to aid in preventing fluid from entering the shoe while keeping the user's foot cool and dry.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margolin 2,347,207 in view of Simmons 4,682,425 and Polegato 5,983,524. Margolin '207 discloses all the limitations of the claims including the following: a sole for a shoe with a tread (that area that is placed on the top side of the outsole); through holes extending entirely through a thickness of the tread (that with 11 located therein); inserts 11 made of plastic (See col. 1, lines 33-37) assembled in the through holes; the insert having through holes 18 located therein allowing for vapor to pass there through; the inserts form antislip and wear preventing protrusions (see Figures 7 and 8, bosses 35 placed in the aeration holes in the sole to aid in holding the hole open would form antislip projections which would aid in gaining grip.). Margolin '207 does not teach that

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the sole can be made of leather, a vapor permeable layer located on the upward sole region, the details to this membrane, a protective layer located on the membrane and the tread being injection molded. Simmons '425 teaches that a shoe insole can be made of leather (see Abstract) to aid in providing comfort for the user. Therefore, it would have been obvious to make the insole of Margolin '207 out of leather, as taught by Simmons '425, to aid in giving comfort and cushioning to the user during use. Polegato '524 teaches that it is desirable to make the ventilated sole of a shoe impermeable to water yet permeable to vapor to allow for the user's foot to breathe. This is accomplished by covering an upward region of the shoe sole by a membrane 315 made of a material which is permeable to vapor and impermeable to water. To further seal or waterproof the shoe sole, Polegato '524 teaches that the membrane can be sealed to the tread in a peripheral region (see col. 5, lines 54-59). The tread and membrane are further sealed peripherally by a peripheral band 315a and sealed perimetrical by adhesive (see Figures 5-7). Polegato '524 further teaches that a protective layer 316 can be arranged at the upper outlets of through holes to protect the membrane with a vapor permeable or perforated protective layer located above the membrane 318. Polegato '524 also teaches that the sole can be injection molded (See column

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6, lines 29-67). Therefore, it would have been obvious to place a vapor permeable membrane with a protective layer, such as that taught by Polegato '524, on the upward side of the sole of the references as modified above to aid in preventing fluid from entering the shoe while keeping the user's foot cool and dry.

***(11) Response to Argument***

Appellant argues 2 issues, and the Examiner's response with respect to these issues will be written in accordance to the order of appellant's arguments.

**Response to Issue 1**

Appellant argues that the sole of Dassler is not made of leather but is made of a material which is itself a water barrier and so the water impregnation problem noted in the arguments would not arise and one of ordinary skill in the art would not have been motivated to add a water impermeable layer onto the sole 5 of Dassler. This argument is not clearly understood. It is agreed and noted in the Final Office action, that the sole of Dassler is not made of leather, but the problem of water entering the shoe of Dassler would still arise as water may enter the shoe of Dassler through the holes 8 (venting channels) in the sole. Therefore, to prevent the water from entering the shoe interior and still allow for the flow through of air to vent the shoe, one of ordinary skill in the art would

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look to the teaching of Ohashi to place a membrane 16 over the inserts in the holes to prevent water from entering the shoe during use. With respect to appellant's arguments that Dassler does provide inserts 9 in the through holes but these inserts are merely filter inserts which would not be needed if a membrane were present, this argument is also unclear. Dassler teaches the use of inserts in the shoe of a shoe and the sides of the shoe to allow for air flow and ventilation of the interior of the shoe. Although the inserts would filter out larger particles, the addition of the membrane would filter out smaller particles as well as water or liquids. Therefore, to prevent any liquids from flowing into the shoe through the filters of Dassler, a membrane would be necessary as the holes in the inserts would allow for liquids to pass into the interior of the shoe and dampen the user's foot, making the user uncomfortable.

With respect to appellant's arguments that Squadroni teaches that the sole is "most preferably" formed of rubber and thus provides to those skilled in the art that soles requiring ventilation are preferably formed of rubber, this argument is unclear. Squadroni teaches that soles, either leather or rubber, "preferably made of leather or rubber, most preferably made of rubber" (see col. 2, lines 66-67) can be provided with

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the discharge valve, shown to be the holes in the bottom of the shoe sole, to allow for ventilation of the shoe interior. With respect to appellant's arguments that Squadroni teaches that "using membranes made of special material is to be avoided", this argument is unclear. Squadroni was only used to teach that soles or ventilated soles can be made of rubber and not for any other material that may be used in the shoe.

With respect to appellant's argument that Polegato cannot teach that the sole can be made from leather, this argument is not clearly understood, as Polegato was not used for this teaching. Lastly, appellant argues that Ohashi teaches plastic inserts in a sole of a ski boot having a hard plastic shell and there is no reason why one of ordinary skill in the art would have been motivated to include plastic inserts for ventilation holes of a leather sole. This argument is also not clearly understood. Ohashi teaches the use of plastic inserts in a ventilated sole and Squadroni teaches that a ventilated sole can be made of leather. Ohashi was not used to teach the use of plastic inserts in a leather sole, only that Ohashi teaches the use of plastic inserts in a ventilated sole.

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Response to Second Issue Arguments

Upon further review of the prior art applied, i.e. Margolin '207 in view of Simmons '425 and Polegato '524, and the appellant's arguments with respect Margolin lacking multiple openings and inserts, the examiner is withdrawing this rejection to the claims as it is now believed that this combination of references does not read on the claims of the instant application.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Anthony D. Stashick  
Primary Examiner  
Art Unit 3728

ADS  
April 11, 2003

Conferees:



Mickey Yu  
Supervisory Patent Examiner  
Group 3700

  
M.D. Patterson  
Primary Examiner